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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,840	07/23/2003	David M. Haugen	WEAT/0116.C1	8946
36735	7590	04/15/2005	EXAMINER	
MOSER, PATTERSON & SHERIDAN, L.L.P. 3040 POST OAK BOULEVARD, SUITE 1500 HOUSTON, TX 77056-6582			WALKER, ZAKIYA NICOLE	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/625,840	HAUGEN, DAVID M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Zakiya N. Walker	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 14-19, 22, 23 and 26-29 is/are rejected.
- 7) ☒ Claim(s) 11, 13, 20, 21, 24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12082003.06102004.</u>  | 6) <input type="checkbox"/> Other: ____                                     |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rack of claim 2, the casing string in a non-vertical position of claim 18, and the cutting member of claims 7 and 26 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-10, 12, 14-19, 22, 23, and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,800,968 or US 4,625,796 (both cited by applicant).

US'968 discloses a system that includes an apparatus for use with a top drive 1, comprising: a pivotable mechanism 30 connected to a lower end of the top drive, wherein the pivotable mechanism has a bore therethrough and is pivotable towards and away from the top drive; and a gripping head 10 connected to a lower end of the pivotable mechanism and pivotable by the pivotable mechanism, wherein the gripping head grippingly engages a casing string. With respect to claim 2, the reference discloses an apparatus for picking up a casing string from a rack and moving the casing string toward a center of a well for use with a top drive 1, comprising: a tubular gripping member 10 attached to a structural intermediate 30, wherein the structural intermediate is pivotable from the top drive to move the casing string toward the center of the well. With respect to depending claims 3-5, the reference teaches the limitations as claimed including compensator 27. With respect to claim 6, the reference teaches a method for use in drilling with casing with a top drive 1, comprising: providing a tubular gripping member 10 pivotally connected to the top drive, wherein the tubular gripping member is rotatable relative to the top drive; locating the top drive at a center of a well; pivoting the

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tubular gripping member away from the center of the well; engaging a casing with the tubular gripping member; and pivoting the tubular gripping member toward the center of the well. With respect to depending claims 7-10, 12, 14, and 15, the reference teaches the method as claimed. With respect to claim 16, the reference discloses a method for moving a casing string to a center of a well, comprising: providing a top drive 1 and a tubular gripping member 10 pivotally connected by a tubular structural intermediate 30; pivoting the structural intermediate to bias the tubular gripping member toward the casing string; grippingly engaging the casing string with the tubular gripping member so that the casing string and the tubular gripping member are rotationally and axially fixed relative to one another; and moving the casing string to the center of the well. With respect to depending claim 17, the reference teaches the limitation as claimed. With respect to claim 18, the reference discloses a top drive adapter for gripping a casing string in a non-vertical position with respect to the center of a well, comprising: a tubular gripping member 10 for gripping the casing string in the non-vertical position; and a tubular structural intermediate 30 for biasing the tubular gripping member away from the center of the well, wherein the top drive adapter is rotatable relative to the top drive. With respect to claim 19, the reference teaches the limitation as claimed. With respect to claim 22, the reference discloses a system for handling a tubular, comprising: a top drive 1; a first gripping member (above lock) operatively coupled to the top drive; a second gripping member (below lock); and an interlock system 38, 39 for ensuring that at least one of the first gripping member or the second gripping member is connected to

the tubular. With respect to depending claim 26-29, the reference teaches the limitations as claimed.

US'796 discloses a system that includes an apparatus for use with a top drive 19, comprising: a pivotable mechanism 158 connected to a lower end of the top drive, wherein the pivotable mechanism has a bore therethrough and is pivotable towards and away from the top drive; and a gripping head 42, 156 connected to a lower end of the pivotable mechanism and pivotable by the pivotable mechanism, wherein the gripping head grippingly engages a casing string. With respect to claim 2, the reference discloses an apparatus for picking up a casing string from a rack and moving the casing string toward a center of a well for use with a top drive 19, comprising: a tubular gripping member 156 attached to a structural intermediate 158, wherein the structural intermediate is pivotable from the top drive to move the casing string toward the center of the well. With respect to depending claims 3-5, the reference teaches the limitations as claimed including compensator. With respect to claim 6, the reference teaches a method for use in drilling with casing with a top drive 19, comprising: providing a tubular gripping member 42, 156 pivotally connected to the top drive, wherein the tubular gripping member is rotatable relative to the top drive; locating the top drive at a center of a well; pivoting the tubular gripping member away from the center of the well; engaging a casing with the tubular gripping member; and pivoting the tubular gripping member toward the center of the well. With respect to depending claims 7-10, 12, 14, and 15, the reference teaches the method as claimed. With respect to claim 16, the reference discloses a method for moving a casing string to a center of a well, comprising:

providing a top drive 19 and a tubular gripping member 42, 156 pivotally connected by a tubular structural intermediate 158; pivoting the structural intermediate to bias the tubular gripping member toward the casing string; grippingly engaging the casing string with the tubular gripping member so that the casing string and the tubular gripping member are rotationally and axially fixed relative to one another; and moving the casing string to the center of the well. With respect to depending claim 17, the reference teaches the limitation as claimed. With respect to claim 18, the reference discloses a top drive adapter for gripping a casing string in a non-vertical position with respect to the center of a well, comprising: a tubular gripping member 42, 156 for gripping the casing string in the non-vertical position; and a tubular structural intermediate 158 for biasing the tubular gripping member away from the center of the well, wherein the top drive adapter is rotatable relative to the top drive. With respect to claim 19, the reference teaches the limitation as claimed. With respect to claim 22, the reference discloses a system for handling a tubular, comprising: a top drive 19; a first gripping member 62 operatively coupled to the top drive; a second gripping member 63; and an interlock system 148 for ensuring that at least one of the first gripping member or the second gripping member is connected to the tubular. With respect to depending claim 26-29, the reference teaches the limitations as claimed.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of U.S. Patent No. 6,742,596. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of the instant invention is merely a broadened form of the US'596 claim. Therefore, it would have been considered obvious to one of ordinary skill in the art at the time the invention was made to have included claim 22 within the parent application/US'596 in order to obtain broader patent protection.

6. Claim 6 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10/794,797. Although the conflicting claims are not identical, they are not patentably distinct from each other because the two claims have the same scope. The instant invention adds an obvious limitation of the top drive being at the center of the well.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



***Allowable Subject Matter***

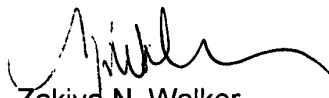
7. Claims 11, 13, 20, 21, 24, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya N. Walker whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Zakiya N. Walker  
Primary Examiner  
Art Unit 3672

zw  
April 13, 2005